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MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1972.

No. 72-626

UNIVERSITY OF ILLINOIS FOUNDATION,
Petitioner.

vs.

BLONDER-TONGUE LABORATORIES, INC.,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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Respondent opposes the petition for a writ of certiorari to the United States Court of Appeals for the Seventh Circuit in this cause.

RESTATEMENT OF QUESTIONS PRESENTED.

Petitioner's three questions, in substance, actually inquire as follows:

Did the Supreme Court really mean to subject petitioner to the unanimously enunciated doctrine and remand in the Blonder-Tongue decision (402 U. S. 313)?

Or, was petitioner to be an implied exception to the doctrine such that:

(Questions 1 & 2)

> the lower courts on remand were to review and pass on the standards of patentability applied in the earlier Eighth Circuit decisions*: and

(Question 3)

> petitioner personally was to be excluded from the application of the estoppel for economic reasons?

Otherwise stated, the petitioner's questions really seem to ask if this Supreme Court will overrule itself.

REASONS FOR DENYING THE WRIT.

In its prior decision this Supreme Court, with full knowledge of the circumstances of the case, unanimously remanded with the direction:

> "Petitioner should be allowed to amend its pleadings in the District Court to assert a plea of estoppel. Respondent must then be permitted to amend its pleadings, and to supplement the record with any evidence showing why an estoppel should not be imposed in this case. If necessary, petitioner may also supplement the record." 402 U. S. 350

The District Court meticulously reviewed and followed that opinion to the letter (A3-8 of Petition) to wit:

a) "The Court accordingly reversed and remanded the case to allow defendant to interpose a plea of estoppel based on the Eighth Circuit's decision in *Winegard*. Upon remand, defendant has accepted the invitation by moving to amend its answer to set up this newly authorized defense. Allowance

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* *University of Illinois Foundation* v. *Winegard*, 271 F. Supp. 412 (S. D. Iowa 1967); affd. 402 F. 2d 125 (CA 8, 1968).

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of the amendment is dictated by the Supreme Court mandate, and plaintiff has not indicated any opposition. The motion is accordingly granted." (A5)

b) "Both parties have disavowed interest in offering evidence on the issue, and no factual issues are presented by the opposing motions. Thus the matter may be appropriately treated as a motion for summary judgment on the defense." (A5)

c) "When a new defendant is sued, the plaintiff will be entitled to relitigate the validity of his patent if he can demonstrate that the prior action did not afford him 'a full and fair chance' to litigate the issue. 402 U. S. 333, 91 S. Ct. 1434. Among the components of this standard are the convenience of the previous forum, plaintiff's incentive to litigate in the prior action, the identity of the issues raised and decided, and the plaintiff's opportunity to present all crucial evidence and witnesses. 402 U. S. 333, 91 S. Ct. 1434. Plaintiff in this Court has made no showing of any shortcomings in the *Winegard* proceedings in any of these respects. Procedurally, at least, plaintiff had a fair opportunity to pursue his claim the first time." (A6)

d) "Plaintiff asserts that the courts of the Eighth Circuit 'wholly failed to grasp the technical subject matter' since they disagreed with the courts of this Circuit. It would demand arrogance so to conclude . . . While the technical subject matter involved in the litigation is complex, *the Eighth Circuit opinion reveals a conscientious effort to apply the standards laid down in Graham* v. *John Deere Co., supra, and a careful evaluation of the issues.* That court concluded that the patent was obvious and invalid as a mere combination of known elements. This Court had reached a different conclusion on the same issue, and this Court's opinion was before the Eighth Circuit. *A mere difference in the conclusions reached in the application of a general standard such as obviousness* under Section 103 of Title 35, United States Code,

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does not demonstrate that either court 'wholly failed to grasp the technical subject matter.' As anticipated by the Supreme Court, instances warranting such a conclusion will be rare. 402 U. S. 333, 91 S. Ct. 1434." (A7) (Emphasis added)

e) "Under the factors mentioned by the Supreme Court, plaintiff has failed to make the requisite showing to escape the defense of estoppel and to entitle it to the benefit of relitigation. Beyond those factors, however, plaintiff urges that allowance of the defense would be unjust and inequitable because it has already incurred the costs and burdens of the second litigation, because this action was filed—but not decided—before the *Winegard* suit, because the Supreme Court denied certiorari to review the Eighth Circuit's decision, and because defendant did not plead the defense of estoppel, or urge its availability, in the courts of this Circuit. *All these circumstances were before the Supreme Court, and with this record before it that Court directed that defendant be given an opportunity in this Court to raise the defense.* This Court cannot evade the mandate by holding that such factors defeat the plea." (A 7, 8) (Emphasis added)

This careful consideration by the District Court of the inquiries ordered by the Supreme Court in its Blonder-Tongue decision was affirmed in toto by the Court of Appeals. Neither Court here abdicated its duty to consider whether the Eighth Circuit Courts, in their validity determination, purported to employ the standards of *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966).

CONCLUSION.

There is no basis in terms of new evidence or public policy dictates, for the Supreme Court now belatedly reversing its unanimous Blonder-Tongue decision, or chang-

ing its mind as to the application of the same to petitioner —the latter proposition, raised by petitioner's questions, indeed being *res judicata*.

The petition is based on no consideration which warrants the grant of a writ of certiorari and should be denied. (Rule 19, Rules of the United States Supreme Court)

Respectfully submitted,

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